

REMARKS

Claims 1-51 are now pending in the application with claims 26-51 having been withdrawn. Claims 1, 9, 15, 18, and 25 are currently amended. No claims have been cancelled and no new claims have been added by this amendment. The Examiner is respectfully requested to reconsider and withdraw the rejections in view of the amendments and remarks contained herein.

REJECTION UNDER 35 U.S.C. § 103

Claims 1-25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over www.teas.uspto.gov retrieved from the Internet Wayback Machine of October 12, 1999, January 10, 2000, and February 8, 2000 ("TEAS") in view of Lee (U.S. Pat. No. 7,016,851) ("Lee") and further in view of Takano (U.S. Pat. No. 6,434,580) ("Takano"). This rejection is respectfully traversed.

The currently amended claims include the feature of displaying country data describing a plurality of countries in which a trade mark application may be filed, where the country data is displayed as a list of countries and a plurality of electronically selectable icons accompanying the list of countries where the icons are individually electronically selectable by a user at a user interface. This feature is not present in any one item of prior art or in any combination of prior art.

Inventive Step

A problem solved by the claimed invention is the efficient filing of trade marks electronically in a simple and user friendly manner, with the minimum of user skill

required, and in a one-shot-one-session process, including acknowledgement that the process has been successful within the same user session.

The claimed invention provides for filing of one or a plurality of trade mark applications in one or a plurality of countries using a single user interface, and with immediate return confirmation of properly received filing information within a same user session, by use of a plurality of listed countries, each individually selectable by a separately selectable icon, making the user experience easy and leaving the user with the knowledge that the filing is correctly instructed, all within the same user session.

This saves the user time and trouble in waiting upon monitoring after-the-event confirmations and under time sensitive conditions enables the user to get on with other jobs, or experience overall stress reduction.

Because there is an acknowledgement message from a remote computer entity, acknowledging that the application is instructed to be filed in one of the plurality countries, including a confirmation information (acknowledgement message) within that same user session, the applicant is assured that the application is properly instructed to be filed, with full confirmation of all the details for filing, for one or a plurality of countries.

Neither TEAS, Lee, nor Takano alone or in combination provides all of the features of the claimed invention. Neither TEAS, Takano nor Lee alone or in combination solves the objective problem.

The claimed invention has novelty, involves an inventive step, and presents a contribution to trade mark processing systems.

Takano US 6,434,580

Takano consists of a patent application management system with provision for interactively producing multiple drafts of a patent specification. Although patent applications are handled via the same Intellectual Property Offices as trade mark applications, a skilled person would not necessarily glean any particular relevant information from Takano concerning trade mark applications, and therefore there is no particular reason why the skilled person would settle on Takano as being a base document from which to build a trade mark application filing system, over and above any other type of known e-commerce system.

Using Takano as a base for the presently claimed invention would lead the skilled person to the unexpected result that almost all of the teaching of Takano would need to be discarded, or was not re-usable or easily modifiable to arrive at the claimed invention which relates to trade marks only. There is practically nothing in the Takano disclosure which is reusable in order to arrive at the claimed invention.

While the Examiner asserts in paragraph 10 of the Office Action that Takano discloses an electronic filing receipt (column 25, lines 45-50, of Takano), there is no disclosure of a CONFIRM ORDER MESSAGE which constitutes a legal acceptance of a transaction for a trade mark.

Takano does not solve the problem of providing a trade mark application filing system in multiple countries. The skilled person would not take Takano as the starting point from which to arrive at the invention, since Takano does not involve trade mark applications.

On the contrary, Takano is aimed at solving a completely different problem as set forth at col. 2, lines 0 – 10, as published, of providing a system capable of preparing patent application documents, including draft documents. The problem is making sure that all the computers are operating the same version of the draft document – a completely different problem from that addressed in the present application. Combining Takano with TEAS would not provide a trade mark application filing system in multiple countries. In particular, the problem of country selection in an easy and user interactive manner is not solved.

Lee

Lee discloses an intellectual property filing portal. Lee discusses the TEAS system, and Lee relates to the filing of trade mark applications.

The problem in Lee is set out at col. 2, line 7 – 23, as a proliferation of foreign requirements and associate-based variations in formal procedures, and the need to maintain up-to-date forms for multiple associates and multiple jurisdictions. Lee discloses a work flow system for selecting associates and is not a single system which allows easy selection of a plurality of states in a mouse-clicking manner by selection of individual country icons.

Lee does not provide an acknowledgement of a trade mark filing instruction, within a user session, but relies on after-the-event confirmation of associate selection.

Lee presents the user with a proliferation of detailed information peculiar to each associate or territory (see col. 7, lines 10 –26) and fails to cut through the complexity of trade mark filing in an efficient manner.

Combining Lee with TEAS to cover a multiplicity of jurisdictions would simply involve an increase in the amount of forms and country specific data presented to a user and the skilled person would expect that the complexity of the operation would prevent a multi-country filing from occurring in a single user session, where the session is from the time of connection online to the time when the user logs out, and in a reasonable session time covering the span of human attention, for example, ten or twenty minutes.

Combining Lee with TEAS would not further the cause of either teaching to solve a new problem. Rather, it would introduce the problems inherent in both systems into a single system with no overall advantage to the user.

The following paragraph numbers coincide with those of the Office action:

9. The person of ordinary skill in the art at the time of the invention would not incorporate into the electronic trade mark application system of TEAS the structure and ability to display country data in which the applicant may file, as disclosed in Lee, because in Lee, this indicates that the "complexities can be exacerbated by the different procedures and requirements of various foreign associates...with whom a managing attorney or an intellectual property owner corresponds" {0007}. Additionally, {0008} Lee states "also, because of the sheet number of potential combination, mistakes are easy to make. Furthermore, the effort necessary to maintain up-to-date forms and procedures can be substantial, particularly for multiple jurisdictions and with multiple foreign associates". In other words, Lee simply discloses a difficulty of the filing procedure in general, but does not explain the difficulty of selecting different sets of goods and

services in combination with selecting different countries, as well as incorporating priority claims into a trade mark application.

While combining Lee with TEAS does in some way recite the features of the claimed invention, a combination of Lee and TEAS together does not disclose all of the features of the presently claimed invention. In particular, the feature of selecting at least one country from a selection of a plurality of listed countries, each selectable by a country icon, is not disclosed.

11. The applicant disagrees that incorporating the electronic receipt taught in Takano into the electronic trade mark filing system of TEAS would not risk an unexpected result. In particular, if the receipt of Takano were sent in response to an on-line trade mark application, the user would have the unexpected result that a receipt for a patent application is received in response to an application for a trade mark, which completely confuses the user of the system, and leads the user of the system to the conclusion that the trade mark application had failed and the user had erroneously received a filing receipt for a patent application.

Further, the receipt in Takano is a receipt that a draft specification has been received. All of the receipts in Takano are concerned with confirming receipt of corrections or amendments in a draft document, consisting of the patent specification or an inventor's report. There is "patent application data" which is received {0125} but this appears to be merely the patent specification itself, not detailed such as applicant or priority date. The word "priority" does not appear in Takano, nor does the word "filing date". This is because Takano is not a system which allows filing of an intellectual

property right. All of the disclosure of Takano relates to the phase before filing something at an intellectual property office, i.e., preparing a document rather than doing the actual filing itself. Consequently, the skilled person would not seek to combine that document with TEAS or Lee, since it relates to a process which is upstream of the actual filing of an intellectual property right.

At {0124} of Takano, there is transmission of a patent application document to a client computer 500 to be used by a patent office.

All of Takano is concerned with drafting and checking a patent specification document. It does not relate to trade marks at all, and does not deal with trade mark application data.

12. In claims 1-8, the invention is restricted to "a method of processing data relating to a trade mark application".

Other Objections:

The Examiner maintains:

Would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate into the electronic trade mark application system of TEAS the structure and ability to display country data in which the applicant may be filed as disclosed in Lee so that a party can file in multiple jurisdictions automatically in accordance with the jurisdiction requirements, since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

The applicant respectfully disagrees. Undue experimentation would be required, and simply adding more countries to TEAS would not solve the goods/ services selection problem, the country selection problem, or the problem of being able to leave

the session in the knowledge that the applications have been correctly instructed in a multiple goods service class and/ or multiple country filing program.

The Examiner asserts:

It would have been obvious to one of ordinary skill in the art to incorporate into the electronic trade mark filing system of TEAS the electronic receipt taught in Takano so one would have immediate proof that the document had been correctly received by the office to which it was being transmitted, thus having proof of filing and priority date, since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

The receipt in Takano is for checking the text of a draft document. It contains different information to that of the present invention. There is no reason why the skilled person would combine the teaching of these two documents.

The Examiner asserts:

As written, applicants claims merely display data, allow a user to input data at a user interface, generate and send/transmit a message/data and receive data. The system comprises at least one processor, at least one communications means, memory/databases, a user interface, a search engine, wherein the system can send and receive data, display a web page. Moreover, generating a confirmed confirmation message confirming said data can be simply presenting the page back to the user entering data to allow them to verify that all of the information is present and correct. This is done on a daily basis when information is being submitted over the internet.

The Examiner imports today's operation of the internet into the analysis, when the operation of the technology at the relevant priority date should be the starting point of analysis.

The Examiner asserts:

Moreover, most of the data being displayed, inputted, received, transmitted, etc is non-functional descriptive data. When presented with a claim comprising descriptive material, an Examiner must determine whether the claimed non-functional descriptive material should be given patentable weight... The PTO may not disregard claim limitations comprised of printed matter.

Looking at this another way, the Examiner concedes that not all the data being displayed is non-functional descriptive data, and the examiner is open to give patentable weight to material. The applicant urges the Examiner to look at the overall merits of the invention and the problem which is solved thereby.

15. The Examiner asserts as follows: "However, the Examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the sub-strate".

Conversely, taking a positive view of an invention, the Examiner is not prohibited from giving patentable weight to descriptive material where there is an overall improvement in a system which is useful . The applicant urges the Examiners' discretion in taking a positive stance on patentability rather than regarding all material of the application as obvious.

16. The Examiner asserts:

Thus, when the prior art describes all the claims structural and functional relationships between the descriptive material and the sub-straight, but the prior art describes a different descriptive material than the claim, then the descriptive material is non-functional and will not be given any patentable weight. That is, such a scenario presents no new and unobvious functional relationship between the descriptive material and the sub-strate.

The applicant submits that the invention is useful and enables the computer platform substrate to do something new and useful to mankind, i.e., save people time and hassle in filing trademark applications. The applicant submits that adapting a computer platform to save humans time and stress in a trade mark filing scenario is a useful end result worthy of the limited duration protection granted by a patent. Completing multi-country-multi-goods/ services trade mark applications in an efficient manner gives rise to a new overall function of a more efficient system based on a computer substrate. The overall result is an improved machine for use by humans.

17. The Examiner states:

The Examiner asserts that the data adds little, if anything, to the claimed acts or steps and thus do not serve as limitations on the claims to distinguish over the prior art".. "Any differences relating merely to the meaning and information conveyed through data which does not explicitly alter or impact the steps is non-function descriptive data. Except for the meaning to the human mind, the data does not functionally relate to the sub-straight and thus does not change the steps of the method as claimed. The subjective interpretation of the data does not patentably distinguish the claimed invention.

The applicant respectfully disagrees with the Examiner, but in any case the claims has been further limited since this statement.

As a general point, in a negative frame of mind the Examiner may be able to find many reasons to deny the applicant patent protection. However, the objective of the patent system is not to deny patent protection for inventions which make progress in the art and which are useful and new. The progress need not be worthy of Nobel prize winning genius, but, rather, even modest inventive steps can be accommodated in the system.

In the present case, the claimed invention is not devoid of all inventive merit altogether, and is not obvious to the level that any skilled person would immediately and diligently seek out all combinations of prior art to arrive at the combined features. Rather, if they tried to do so, they would find essential elements of the invention missing from their compilation.

Further, the skilled person would find that the benefit of the present invention was not achieved by a combination of known features and the resultant systems derived solely from the prior art would not achieve the resultant operation of the claimed invention.

The applicant submits that the invention as presently claimed is novel and contains an inventive step. Further and favorable consideration of the present application is urged.


CONCLUSION

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action and the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested.

If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

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